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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,085	11/25/2003	David W. Boykin	421/60/20/2	7150

25297 7590 06/08/2005

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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT PAPER NUMBER

1626

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,085

Applicant(s)

BOYKIN ET AL.

Examiner

Taofiq A. Solola

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 1-11 are pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification fails to disclose that all known bis-aryl diamidoxime compounds, all amidoxime aryl halides and all 2,5-bis trialkylstannanes are embraced by the instant process. This is also true for aprotic solvents and palladium catalysts. The starting reagents, catalyst, etc. are critical elements of the invention and must be sufficiently disclosed (identified). No exclusive definitions of these elements are disclosed in the specification. Rather, few examples are cited and only one working example is disclosed for each element. Therefore, the specification fails to provide adequate support for claims 1-11. Applicant may not claim all amidoxime aryl halides, all 2,5-bis trialkylstannanes, aprotic solvents and palladium catalysts, known and yet to be discovered, that may or may not be applicable in the instant process. Applicant must claim only amidoxime aryl halides, 2,5-bis trialkylstannanes, aprotic solvents and palladium catalysts that embody Applicant's invention, having support in the specification.

Applicant must show possession of the invention by describing it with all the claimed limitations. *Lookwood v. American Airlines Inc.* 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966

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(Fed Cir. 1997). By adding the structure of 2,5-bis tributylstannylfuran replacing the furan oxygen with Q, and add claims 2-3, 6-7 to claim 1 the rejection would be overcome.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "comprises", line 2, claim 2, renders the claim indefinite. The term is open-ended and may not be used in reference to a compound. By replacing "compound comprises" with "compounds have" the rejection would be overcome.

Claim 1 fails to define bis-aryl diamidoxime compounds, amidoxime aryl halides, 2,5-bis trialkylstannanes, identify aprotic solvents and palladium catalysts so as to determine the metes and bounds of claims 1-11. Therefore, the claims are indefinite. A claim must stand alone to define the inventions, and incorporation into the claims by reference to the specification or an external source is not permitted. Ex parte Fressola, 27 USPQ 2d 1608, BdPatApp & Inter. (1993). In patent examination, it is essential for claims to be precise, clear, correct, and unambiguous. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). See the Examiner's suggestion above under 35 USC 112, first paragraph.

Claim 4 as amended is confusing and therefore, indefinite. A compound cannot "comprise", it must "have". The term bis 2,5-trialkylstannane refers to any ring having two alkylstannane at positions 2 and 5. Therefore, the claim must recite "the bis 2,5-trialkylstannane having a ring selected from furan, thiophene," etc.

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Applicant's arguments filed 5/2/05 have been fully considered but they are not persuasive. Applicant argues that the Office action fails to set forth why the specification lacks adequate support for the claims. This is not persuasive because the Office action in fact states why the specification lacks adequate support for the claims. For example, claim 1 is not classifiable because the structure of the product is not known. Under the US patent practice, in a process claim the class and subclass(es) of the product must be searched to determine patentability of the process. The term "bis-aryl diamidoxime" is a generic description referring to the two phenyls and their oxime substituents. It does not provide sufficient identity or the complete structure of the product. The scope of claims 1-2 is far beyond the enabling disclosure in the specification. One of ordinary skill in the art would have to perform undue experimentations to determine which bis-ary diamidoxime is being made in claim 1, and which of all the known 2,5-bis trialkystannane, amidoxime aryl halides, aprotic solvents and palladium catalysts are applicable in the practice of claims 1 and 2. Applicant further contends that the specification provides adequate direction for one of ordinary skill in the art to practice the invention. This is not persuasive because the practice of claims 1-2 would come with undue experimentations for reasons set forth herein.

Applicant also argues that a representative description is all that is required to satisfy written description requirement. While this is true, as admitted by applicant, there is a need to disclose relevant identifying characteristics, e.g. structures, which is not true of the products in claim 1 and the reactants in claims 1-2. Applicant further asserts that the specification provides sufficient enablement for the claims. This is not persuasive because if applicant's assertion is correct claims 1 and 2 would be duplicates. This also implies applicant is asking the Examiner to read the specification into the claims, which is contrary to patent practice under the US law. Under the US patent practice, each claim is given the broadest interpretation.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, JD, whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.


TAOFIQ SOLOLA
PRIMARY EXAMINER
Group 1626

June 1, 2005